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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 Ex parte KENICHI MIYAZAKI
11

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13 Appeal 2007-3300
14 Application 09/386,000
15 Technology Center 3600
16

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18 Oral Hearing Held: September 9, 2008
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21
22 Before MICHAEL R. FLEMING, *Chief Administrative Judge*,
23 ALLEN R. MacDONALD, *Vice Chief Administrative Judge*, and
24 HUBERT LORIN, ANTON W. FETTING, and DAVID B. WALKER,
25 Administrative Patent Judges

26
27 ON BEHALF OF THE APPELLANT:
28

29 DAVID P. EMERY, ESQUIRE
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34 The above-entitled matter came on for hearing on September 9, 2008, at the
35 U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia,
36 before Dominico Quattrociocchi, Free State Reporting, Inc.

P R O C E E D I N G S

MS. BOBO-ALLEN: Good afternoon. Calendar No. 4, Appeal No. 2007-3300. Mr. Emery.

JUDGE FLEMING: Good afternoon. You can proceed when you're ready.

MR. EMERY: My name is Dave Emery. I'm here to represent the assignee's appeal. Generally, I'm going to start out talking about the structure of the claims, and there are several independent claims and there'er just some main claim features that are kind of in contention that have been argued. One of them relates to using a paper roll and feeding a stiff carton, and the other feature relates to the height of the feeding unit, or sheet-feeding unit. Those are the basic features, except for we have one claim, a 103 rejection, to Claim 15 which schedules a cover -- and I'll cover that at the end.

Basically, the claim features relating to height recites -- and there's some minor variations -- the paper-feeding unit being located at a height that enables a user, who is approximately 170 centimeters tall, standing in front of the printer to execute the paper-feeding process.

The first rejection I want to address is there's a rejection under 35 U.S.C. 112, and the examiner kind of made some questions, saying this was indefinite, and he asked some questions like what is the height? Is the applicant claiming the person? Is a person sitting or kneeling? And he's claiming the claim, with not a whole lot of clarity, that this is indefinite. And as you've probably reviewed in the reply brief in detail, we shadow Orthokinetics case where the legs of a wheelchair are sized so as to fit in a

1 car, and basically what we have in our claim is we have a dimension that we
2 are comparing to a reference to size it, and here we're comparing it to a
3 standing person. And, you know, we think that our claim is as definite as
4 the claim in Orthokinetics.

5 Orthokinetics, the claim recites said front leg portion so dimensioned
6 as to be insertable through the space between the door frame of an
7 automobile and one of the seats thereof. In that claim instance, you could
8 have many different cars which would show many dimensions, varying, and
9 we recite something as probably more stable and more consistent, which is
10 the height of a standing person. So our contention is that this is a definite
11 feature, as recited in each of the claims.

12 And even further yet, some of the claims go on to say, you know, the
13 feature of 170 centimeters, which is much more definite, even further
14 definite than the claim just of a height of a person.

15 The second rejection we're going to address is there's an anticipation
16 rejection in view of Yamada. That's a 102(e) reference. And each of the
17 independent claims rejected here recites a paper-feeding unit operable to
18 feed at least one roll of paper, at least one substantially flat sheet of paper,
19 and at least one stiff carton.

20 With reference to Figures 1 and 2 of Yamada, it's quite apparent that
21 the reference only shows a paper-feeding unit that feeds rolls of paper.
22 Figure 2 shows a configuration where there are three rolls, rolls 101, 102,
23 and 103, and Yamada nowhere addresses the stiff carton feature. We also
24 don't believe this is an inherent feature as this only shows rolls.

25 The examiner cites to a portion that -- this portion's column 5 -- lines
26 45 to 55, and basically these portions just refer to the roll sheets 102, 101,

1 and 103, and makes no further reference to having a -- feeding a stiff carton.
2 And again, with reference to Figure 2, we just don't believe this reference
3 discloses that feature.

4 The examiner also seems to make the argument that we -- he does this
5 in several of these rejections. He parallels that -- he relies on the Manual of
6 Patent Examination Procedure, Section 2115, and he alleges that the material
7 or article worked on does not limit the claims, and we're not trying to claim
8 the article worked on, the paper. What we're saying is that we have a paper-
9 feeding unit which is operable, so we're claiming a structural feature, and it's
10 a feature of the paper-feeding unit and not -- we're not claiming the paper
11 itself or the fact that it has a paper. So whether the paper's present or not, we
12 feel we have defined an apparatus that has a paper-feeding unit that's
13 operable to feed these units -- or types of paper.

14 JUDGE HORNER: Can we go back to the 112?

15 MR. EMERY: Sure.

16 JUDGE HORNER: I don't see in any of the claims rejected there's a
17 112 relationship between the user -- a specific relationship between the user
18 and the printer. I think the trouble I'm having is that in all of these claims
19 you're saying, for example, the user is standing in front of the printer but
20 you're not saying where the user is standing in relationship to where the
21 printer is sitting. So for example, in some cases you've got the printer
22 standing substantially at ground level but you don't have anything that says
23 where the -- if the user is also at ground level, is that that same level or is
24 there a different level? There's no relationship defined between the two. So
25 even in the claims that get more specific as to the height of the user, for
26 example, 13, claim 13 which talks about a user being approximately 170

1 centimeters tall and that they can set up the printing medium without having
2 to substantially bend at the waist, when they're standing erect in front of the
3 printer -- well, there you have substantially a ground-level but there you
4 don't have in that claim where the printer is placed.

5 MR. EMERY: In claim 13?

6 JUDGE HORNER: Yeah.

7 MR. EMERY: Specifically, in claim 13 or just in all of them?

8 JUDGE HORNER: Well, no that's for all the claims, because they're
9 all worded differently.

10 MR. EMERY: Well, I think the way the claim's recited, you -- it's
11 inherent in the claim, implicit that the paper-feeding unit would be measured
12 from the same distance that the person's feet would be. So if you took a
13 person's height, you're saying the person's height from, you know -- and you
14 look at the specifications from the feet to whatever portion, I think you
15 would say that -- you know, you would compare that to the height of the
16 printer, which would be the bottom of the printer to the elevation at the
17 paper-feeding unit.

18 JUDGE HORNER: Well, let's say for example the printer's on a
19 table, because not all these printers -- require the printer to be on the ground.
20 It's not really clear in some of these claims where the height of the printer is
21 versus the user's -- where the user is standing.

22 MR. EMERY: Yeah, I think -- I mean, I think that --you know,
23 looking at in view of the specification, I think that's pretty apparent, what is
24 meant by that phrase.

25 JUDGE FLEMING: Well, we're going to have to read in this
26 limitation from the specification?

1 MR. EMERY: Excuse me?

2 JUDGE FLEMING: We're going to have to read in from the
3 specification to make this claim definite?

4 MR. EMERY: I think that one skilled in the art looking at this claim,
5 having not looked at the specification, would understand.

6 JUDGE FLEMING: Well, printers are on tables, printers are on
7 floors. How are we supposed to know?

8 MR. EMERY: I, you know --

9 JUDGE FLEMING: One of ordinary skill knows that printers can be
10 put on tables. Most of our printers are on -- how would we know it's
11 supposed to be there? And then we have other printers that are on floors. So
12 one of ordinary skill in the art would know that there are a lot of different
13 relationships between a printer and a person.

14 MR. EMERY: Our position is that the claim is sufficiently definite as
15 it is written, but I understand your view.

16 JUDGE MacDONALD: I think the question we're raising is a little
17 more than a view. The examiner expressed a concern, and it sounds like
18 there's multiple ways this can be used, what error has the examiner made in
19 there raising a -- question?

20 MR. EMERY: Well, I think the examiner -- you know, I don't believe
21 the examiner was explicitly clear that he was talking about point. He talked
22 about the person kneeling or bending as opposed to standing, and the
23 examiner also, you know, kind of thought it was confusing because how do
24 you determine infringement if it's based off the height of a person.

25 JUDGE MacDONALD: Well, it's for the same basic question,
26 though. It's the relationship between the person and the printer, and that's

1 not expressed in the claim, as opposed to the case you cited where there are
2 relationships. You know, the doors and wheels have a relationship. The
3 wheels have to be smaller than the door opening is, so there's a specified
4 relationship between the two, and that doesn't seem to come across in the
5 claim.

6 MR. EMERY: So you're -- if I'm to understand your point properly,
7 you're saying that the height from where you measure the person isn't quite
8 clear from the claim language?

9 JUDGE MacDONALD: Well, you have the height of the person and
10 you have a certain type of printer, but the key here is what's the relationship
11 between the two of them other than convenience.

12 MR. EMERY: I understand your point.

13 JUDGE FLEMING: Please go on.

14 MR. EMERY: Okay, next I'll move to Orbons and, you know,
15 Orbons again is cited under 102's anticipation reference, and based off of our
16 interpretation of the claim language we think that Orbons doesn't disclose
17 that -- the printer feeding unit is at a height that enables a standing person to
18 feed the unit. And what we cite to is it does disclose a worktop that is kind
19 of claimed as a working height for a standing operator, and, you know, in a
20 similar way Orbons reference makes these claims, and it is written by one
21 skilled in the art, that kind of implies that a person would be standing on the
22 same level as the printer. You know, it's kind of on the same parallel path
23 that we've taken with our claim language.

24 But anyway, comparing those in the same way, it says this worktop is
25 at the working height, and then it shows a feed unit which is located below

1 that height. So, you know, interpretation of the claim that we're pushing, we
2 feel that Orbons does not anticipate all those features that are shown.

3 And further, in regard to Claim 26, we don't think there's any portion
4 of Orbons -- Orbons discloses rolls, it doesn't disclose the stiff card feature
5 that we've recited in our claims.

6 JUDGE HORNER: Can you take a minute and take a look at the
7 wording of that Claim 26?

8 MR. EMERY: Sure.

9 JUDGE HORNER: Is there something unusual only because this
10 claim has only one element, and it's describing an area rather than -- you
11 have an area -- to one of these three types of --

12 MR. EMERY: Yes.

13 JUDGE HORNER: Is this a means plus function claim that is
14 claiming something operable in the form of a particular function but it's not
15 specifically claiming structure?

16 MR. EMERY: This claim, you know, it's -- I think that, you know --
17 one skilled in the art, I don't think that's necessarily so. I think that one
18 skilled in the art might understand that a sheet-feeding area is an area that's
19 bound by certain structure, and --

20 JUDGE HORNER: Where would we find that structure, in the
21 specifications?

22 MR. EMERY: Where would you find it?

23 JUDGE HORNER: Right.

24 MR. EMERY: Yes, I think you would find it in the specification. I
25 mean, I think it shows feeding paths and areas. Figure 2 is probably the best
26 --

1 JUDGE MacDONALD: So this terminology in the claim is not an art
2 standard term?

3 MR. EMERY: You know, there may not be sufficient structure in that
4 claim, so that may be a claim where you need to define that as means plus
5 function since there isn't much structure recited in this claim. Just says a
6 sheet-feeding area. And area -- I guess, you know, in reality an area is not
7 really a structural as much as a functional space for the paper.

8 Any other questions on that point? Okay.

9 Okay, the next rejection is another 102(b), and that's in view of the
10 IP4000 device. This is a Japanese publication. And again, with this device,
11 we feel this doesn't teach the stiff card feature. It merely only discloses rolls
12 in the feeding of rolls. If you look at page 2 of the reference, it shows the
13 feeding area and it shows three rolls at the top portion and doesn't show any
14 other feeding method, so we feel this is not an anticipatory reference for that
15 reason alone.

16 And the next rejection is the OCE9400 device. This is another 102(b)
17 rejection regarding the features of the claim. We do not feel this discloses
18 feeding the stiff carton. This reference makes -- this reference kind of
19 identifies some things called originals, and it also appears to disclose that
20 this is a printer and a copier. In our view, that the paper-feeding unit is part
21 of the printing portion and that there would be a table, scanning table for the
22 copying portion, and we don't believe that this is -- it's inherent within this
23 reference that it would necessarily be able to feed thick carton material.

24 And the examiner also relied on a portion of this, that -- in the reply
25 brief it's a digital ES handout which is dated July 2004. We don't think that's
26 necessarily prior art. They don't use any proof showing that this device had

1 maintained the same features throughout its life, between 1997 and 2004.
2 So we don't think it's proper for the examiner to rely on those portions as
3 well.

4 And in regard to claim 13, we -- it's our view that it's not necessarily -
5 - this feature that -- the sheet-feeding unit, our position that a height at which
6 a user standing in front of the printing unit would be able to feed the printer.
7 We don't think there's any -- it's clear that that would necessarily be met as
8 well for that feature.

9 Then there's another 102(b) reference in view of Japanese publication
10 Takumi. This is another reference that does not clearly show the stiff carton
11 feature. It appears to show rolls, roll form, and the only thing addressed is
12 paper in a roll and that is within the abstract, talking about paper in a roll
13 form is moved in a certain direction. So again we don't think this shows the
14 stiff carton feature.

15 I'm going to move to rejections and impact claims in view of some
16 obviousness rejections, and the first one is
17 McCulley and Smedal. And with regard to claim 13, we don't think this
18 discloses or one skilled in the art would combine this so as to meet the
19 feature, the feature being a sheet-feeding area that's positioned at a height at
20 which a user who's approximately 170 centimeters tall can set up a printing
21 medium without having to bend substantially at the waist. And in the
22 rejection, the examiner applies McCulley as teaching most of the features
23 and -- but kind of concedes that McCulley doesn't disclose the claimed
24 height feature and relies on Smedal. And we believe the application of
25 Smedal he's kind of saying that looking at Smedal you could move this
26 paper-loading apparatus to any height and you would put it at the height of --

1 for a user to feed it. We think the reference has been a little
2 mischaracterized, and if you look at this reference, Smedal, on page 2, lines
3 55 to 65, it kind of talks about from instruction so far shown described it will
4 be seen that the attachment per se is entirely independent of a typewriting
5 machine and in order that it may be readily placed in operative relation with
6 machines of different makes. So we felt the idea of this adjustable height
7 feature is so this can be placed to enable you to operate it on different
8 machines and not necessarily so that you would set it at the height which a
9 human can load a printing unit. We think it's more machine dependent than
10 it is user dependent, and I would think one skilled in the art would not
11 modify it.

12 And there's another 103 reference -- or rejection on claim 15 we
13 wanted to address, and this is Hageman and Metzner, and this is directed to
14 the cover feature of claim 15, and that feature recites a cover -- the cover is
15 the first feeding path for a roll of paper from above and which supports at
16 least the -- of the sheet of paper and the stiff carton from below. The
17 examiner applies Hageman first. He's relying on Hageman's housing 45
18 which is kind of an almost circular piece around a carbon roll, and this is
19 evident and kind of illustrated well in Figure 4. And he also relies on
20 guideplates 42 at the bottom of Hageman, down by the printing unit. But he
21 kind of concedes that these don't meet all the features because they aren't --
22 they're separate units.

23 So then he goes on to apply Metzner, and Metzner shows a single
24 guide that runs the length of the unit, and he says it would be obvious in
25 view of Metzner to make this modification, and we kind of think that
26 Hageman teaches away from this. And specifically, it's the function of the

1 housing 45 which the examiner is relying on, and essentially Hageman
2 teaches the housing has pins which slide and engage in slots 54 and in plates
3 44 of the carriage so that the housing can be inserted into and removed from
4 the carriage, and then this enables a user to replace carbon roll 46 by
5 removing the entire housing from the carriage. And we feel if you combine
6 this with the guideplates you would lose that removability and, therefore,
7 one skilled in the art would not make that modification. It would destroy the
8 principle of operation of that housing 54. And that's our basis that we think
9 the rejection letter at Hageman and Metzner is not supported and would not
10 be obvious to one skilled in the art.

11 I'll open it up to you all if you have any further questions. No? Okay,
12 well, thank you.

13 JUDGE MacDONALD: Thank you.

14 (Whereupon, the hearing concluded at 1:25 p.m. on September 9, 2008.)